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MAY 10 2002

In re Application of	:	OFFICE OF PETITIONS
John R. Bianchi et al.	:	
Application No. 09/782,594	:	DECISION GRANTING DECISION
Filed: February 12, 2001	:	UNDER 37 CFR 1.78(a)(3)
Attorney Docket No. RTI-112R	:	

This is a decision on the Response to Decision Dismissing Petition under 37 CFR 1.78(a)(3), filed January 7, 2002, to accept an unintentionally delayed claim under 35 USC 120 for the benefit of two prior filed copending nonprovisional applications, numbers 08/920,630, filed August 27, 1997, and 09/701,933, filed August 25, 1998. A petition for a five (5) month extension of time is also requested and is hereby granted.

The petition is **dismissed**.

Any further petition to revive the above-identified application must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Petition under 37 CFR 1.78." This is **not** final agency action within the meaning of 5 U.S.C. § 704.

## Background

A petition to accept an unintentionally delayed claim for the benefit of two prior filed copending applications, filed July 25, 2001, was dismissed by this Office in a Decision mailed on September 5, 2001, because a reference to the subject two prior nonprovisional applications had not been included in an ADS as provided by 37 CFR 1.76 or in the first sentence of the specification following the title as required by 37 CFR 1.78(a)(2). Also, the statement in the first line of the specification which stated that "[t]his application is a continuation-in-part of pending provisional application serial number 60/181,622" was improper.

It was noted in the Decision that, in this regard, an application claiming the benefits of a provisional application under 35 USC 119(e) should not be called a continuation, a division, or a

continuation-in-part. Note MPEP 201.07, 201.08 and 306.01. It was also noted that it appeared that incorrect application numbers were included in the claim for priority under 35 USC 120 in the first sentence of the specification following the title; namely, "09/370,194" should have read -- 09/390,194<sup>1</sup> -- and "09/191,132" should have read -- 09/191,232 -- . It was further noted that the incorrect application numbers also appeared in the executed declaration received May 25, 2001.

A further review of the file record disclosed that the reply to the Notice to File Missing Parts (Notice) was defective in that the executed Declaration and Power of Attorney lacked the citizenship of inventors P. J. Gorham and Michael Esch as required by 35 USC 115. A declaration in compliance with 35 USC 115 and 37 CFR 1.63(a)(3) was required.

Finally, it was noted that the preliminary amendment under 37 CFR 1.115 accompanying the instant petition was unsigned. A signed amendment was required if petitioner desired to have the preliminary amendment considered.

#### Applicable Law

A petition under 37 CFR 1.78(a)(3) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after the expiration of the period specified in 37 CFR 1.78(a)(2), and must be filed during the pendency of the nonprovisional application. In addition, the petition must accompanied by:

- (1) the surcharge as set forth in 37 CFR 1.17(t);
- (2) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2) and the date the claim was filed as unintentional; and
- (3) the reference to the prior filed nonprovisional application, supplied in an application data sheet, or as an amendment in the first sentence following the title. See 35 USC 120 and 37 CFR 1.78(a)(2). The Commissioner may require additional information where there is a question whether the delay was unintentional.

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<sup>1</sup>It is noted that the application serial number should have read 09/390,174. Petitioner has made this correction on the Second Preliminary Amendment submitted with the instant petition.

The Instant Petition

This petition lacks item (3).

The first line of the specification has been amended to state:

This application is a continuation-in-part of pending application serial numbers 09/191,232, filed on November 13, 1998, pending; and of 09/378,527, filed on August 20, 1999, pending; and of 09/390,174, filed on September 7, 1999, pending, and of 29/123,227, filed on May 12, 2000, pending. This application is also related to provisional application serial number 60/181,622, filed February 10, 2000, and to non-provisional application number 08/920,630, filed August 27, 1997; and of non-provisional application number 09/701,933, filed August 25, 1998.

The priority of all of the foregoing is claimed herein under 35 U.S.C. §119 and §120. The subject matter and disclosure of all the foregoing is hereby incorporated by reference as if fully set forth herein.

The application currently claims the benefit of application numbers 60/181,622, filed February 10, 2000; 09/191,232, filed on November 13, 1998; 09/378,527, filed on August 20, 1999, and of 09/390,174, filed on September 7, 1999.

The applications for which the benefit is sought are application numbers 29/123,227, filed May 12, 2000; 08/920,630, filed August 27, 1997, and 09/701,933, putatively filed on August 25, 1998. However, Petitioner has not indicated the relationship of the applications for which the benefit is sought and the instant application as required by 37 CFR 1.78(a)(2). That section provides that

[e]xcept for a continued prosecution application filed under 37 CFR 1.53(d), any nonprovisional application claiming the benefit of one or more prior filed copending nonprovisional applications or international applications designating the United States of America must contain a reference to each such prior application, identifying it by application number (consisting of the series code and serial number) or international application number and international filing date and indicating the relationship of the applications. (Emphasis supplied)

Here, Petitioner has not indicated the relationship of the

applications, but simply provided that "[t]his application is also related" to the applications for which the benefit is sought. The Manual for Patent Examining Procedure ("MPEP") §201.11, provides that

"[w]hen a nonprovisional application (other than a CPA) is entitled under 35 U.S.C. 120 to an earlier U.S. effective filing date, a statement such as 'This is a division (continuation, continuation-in-part) of Application No. ---, filed ---' should appear as the first sentence of the description or in an application data sheet, except in the case of a design applications . . ."

Petitioner must amend the specification to state the relationship of the instant application to the application(s) for which the benefit is sought.

Further, the proposed amendment lumps together, and thus confuses, claims for the benefit under both 35 USC 119(e) and 35 USC 120. As noted above, it is inappropriate for applicant to denote a given application as continuation of a continuation-in-part of a provisional application. The proposed amendment is also improper for another reason: where it attempts to incorporate by reference, after the filing date, one or more previous applications. The proposed amendment under 35 USC 120 cannot be accepted as drafted since it improperly incorporates by reference the prior applications. Petitioner's attention is directed to *Dart Industries v. Banner*, 636 F. 2d 684, 207 USPQ273 (C.A.D.C. 1980), where the court drew a distinction between the permissible 35 USC 120 statement, and the impermissible introduction of new matter by way of incorporation by reference in a 35 USC 120 statement. The court specifically stated:

Nothing in section 120 itself operates to carry forward any disclosure from an earlier application. *In re deSeversky, supra* at 674, 177 USPQ at 146-147. Section 120 contains no magical disclosure-augmenting powers able to pierce new matter barriers. It cannot, therefore "limit" the absolute and express prohibition against new matter contained in section 251 [or 132]. *Id.* At 688, 207 USPQ at 276.

Moreover, inspection of the declaration filed January 7, 2002, reveals the same execution dates as the declaration filed May 25, 2001, and, as such, the later filed declaration appears to be a

photocopy of the earlier declaration. However, since the later-filed declaration has been amended to now include the citizenship of the inventors, and such amendment occurred subsequent to signature, it cannot be accepted. See MPEP 206.01. A new declaration is required.

In addition, investigation reveals that application number 09/701,933 lists as a sole inventor, Jamie M. Grooms. The present application, which claims priority to application number 09/701,933, does not list Jamie M. Grooms as an inventor. Thus application number 09/701,933 does not appear eligible for a priority claim within the meaning of 35 USC 120 and 37 CFR 1.78.

Finally, application number 09/701,933 has yet to receive a filing date. Petitioner can not claim the benefit of 09/701,933 as there is no filing date from which a benefit may be claimed.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Assistant Commissioner for Patents  
Box DAC  
Washington, D.C. 20231

By FAX: (703) 308-6916  
Attn: Office of Petitions

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Telephone inquiries concerning this matter should be directed to petitions attorney Derek L. Woods at (703) 305-0014.

  
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Conferee: Brian Hearn